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EXAMINER

BORLINGHAUS, JASON M

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/899,075
Filing Date: July 06, 2001
Appellant(s): HOSHINO, SATOSHI

Ebenesar Thomas
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/22/08 appealing from the Office action mailed 8/15/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5483069 Kofune et al. 12-1993
Specification (US Application 09/899,075)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 8 and 14 - 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kofune (US Patent 5,483,069) in view of Disclosed Prior Art (see pp. 1 – 2).

Regarding Claims 1 - 6, Kofune discloses an authenticity checker of a document (see abstract) comprising:

- an image capturing module (light sensor) for image capturing a watermark of a document from both obverse (via reflection on obverse side through reflection light sensor) and reverse side (via transmission from reverse side through transmission light sensor). (see fig. 6 – 7; col. 5, line 35 – col. 6, line 21);
- said image captured according to an image capturing instruction (light sensors are controlled by data from the position detecting means). (see col. 5, line 35 – col. 6, line 21);
- a document image capturing controller (position detecting means) which outputs the image capturing instruction (data) to the document image

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capturing module at the beginning of the authenticity judging operation (prior to image capturing). (see fig. 7, col. 5, line 35 – col. 6, line 21);

- an authenticity judging module (CPU) which judges the document is a forgery if neither of the watermarks image captured from the obverse nor reverse side by the document image capturing module is recognized as a regular watermark, and judges the document is authentic if at least one of watermarks is recognized as a regular watermark (data outputted from both sensors are compared by a CPU). (see col. 1, lines 16 – 22; col. 5, line 35 – col. 6, line 21);
- first and second cameras (light sensors) to shoot the document. (see fig. 6 – 7; col. 5, line 35 – col. 6, line 21);
- first (reflection light emitter) and second (transmitted light emitter) to irradiate the document from the reverse and obverse side. (see fig. 6 – 7; col. 5, line 35 – col. 6, line 21); and
- a revolving means (conveying means) for revolving (placing) the document between the lens (transmitted light detector) and the light (transmitted light emitter) so that the backside of the document is placed opposite to the lens. (see fig. 6 – 7; col. 5, line 35 – col. 6, line 21).

Kofune does not teach an authenticity checker that checks a **driver's license**; nor first and second cameras to shoot the driver's license **from the obverse and reverse sides**, although Kofune does disclose first and second cameras to shoot watermarks contained on the obverse and reverse sides. (emphasis added).

Disclosed Prior Art discloses an authenticity checker of a driver's license (see p. 1 , lines 15 – 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kofune by incorporating the ability to judge the authenticity of driver's licenses, as disclosed by Disclosed Prior Art, thereby incorporating the speed, efficiency and uniformity of an automated system to judge the authenticity of driver's licenses.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kofune and Disclosed Prior Art to have multiple cameras to capture images from the obverse and reverse sides of a driver's license, as a driver's license is a two-dimensional document having an obverse and reverse side requiring authentication.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have multiple cameras and multiple light sources to capture images of multiple sides or multiple angles of a two-sided document, since it has been held that mere duplication of the essential working parts of a device, without more, involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co*, 193 USPQ 8 (CA 7); *In re Harza*, 124 USPQ 378 (CCPA 1960).

Regarding Claims 7 – 8 and 14 - 15, such claims recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected claims, or are otherwise disclosed by the prior art applied in previously rejected

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claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

(10) Response to Argument

For the ease of the Board, Examiner presents a mapping of the claim limitations of the Claim 1 to the applicable prior art references.

#	<u>Claim 1</u>	<u>Kofune (US Patent 5,483,069)</u>	<u>Disclosed Prior Art</u>
1	An authenticity checker of driver's license comprising:	An authenticity checker of a document (see abstract) comprising:	An authenticity checker of a driver's license (see p. 1, lines 15 – 18).
2	a driver's license image capturing module for image capturing a watermark of a driver's license from both obverse and reverse side; and	an image capturing module (light sensor) for image capturing a watermark of a document from both obverse (via reflection on obverse side through reflection light sensor) and reverse side (via transmission from reverse side through transmission light sensor). (see fig. 6 – 7; col. 5, line 35 – col. 6, line 21);	
3	an authenticity judging module which judges the driver's license is a forgery if in either of the watermarks image captured from the obverse nor reverse side by the driver's license image capturing module is recognized as a regular watermark,	an authenticity judging module (CPU) which judges the document is a forgery if neither of the watermarks image captured from the obverse nor reverse side by the document image capturing module is recognized as a regular watermark, (see col. 1, lines 16 – 22; col. 5, line 35 – col. 6, line 21);	
4	and judges the driver's license is authentic, if at least one of watermarks is recognized as a regular watermark.	and judges the document is authentic if at least one of watermarks is recognized as a regular watermark (data outputted from both sensors are compared by a CPU). (see col. 1, lines 16 – 22; col. 5, line 35 – col. 6, line 21).	

Image Capturing Module

Appellant asserts that Kofune does not disclose “a watermark on the obverse side and a watermark on reverse side” of a driver's license.

First, Examiner refutes such an assertion as such claim limitations were not recited in the previously presented claims nor did the original specification articulate a definition of claim terminology that required such a claim construction. As such, the broadest definition for claim terminology was applied as to provide the “broadest reasonable interpretation consistent with the specification during the examination of a patent application since the applicant may then amend his claims.” See *In re Prater and Wei*, 162 USPQ 541, 550 (CCPA 1969).

Claim 1 claims “capturing a watermark of a driver’s license from both obverse and reverse sides.” (see Claim 1).

Kofune states:

FIGS. 6 and 7 are a side view and a block diagram respectively showing the third embodiment of the validating apparatus relating to the present invention. The validating apparatus conveys a bank bill 1 inserted therein by conveying means 2 such as a belt or the like means and **reads data on watermark patterns of the bank bill through a reflection light sensor 3 and a transmission light sensor 8 provided respectively at predetermined positions to the conveying means 2.** The reflection light sensor 3 and transmission light sensor 8 are controlled by data from the position detecting means 11 cooperatively associated with the conveying means 2 during conveyance of the bank bill 1 for a predetermined transfer distance. (emphasis added - see col. 5, lines 35 – 49).

Examiner asserts that Kofune discloses capturing a watermark (watermark patterns) from the obverse side (via reflection) and reverse side (via transmission).

Kofune states:

In addition, it can be apparently understood that similar result can be obtained by constructing the validating apparatus with three elements, a common light emitter 4, a light detector 5 for receiving reflected light and a light detector 6 for receiving transmitted light, as shown in FIG. 12. (see col. 7, lines 18 – 22).

Examiner asserts that Kofune discloses capturing a watermark (watermark patterns) from the obverse side (via reflection) and reverse side (via transmission).

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Second, even if Applicant's assertion is correct, which the Examiner refutes, and proper claim construction requires an image capturing module located on each side of the driver's license, then such is a mere duplication of the component elements of Kofune. It has been held that mere duplication of the essential working parts of a device, without more, involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co*, 193 USPQ 8 (CA 7); *In re Harza*, 124 USPQ 378 (CCPA 1960).

Examiner asserts that if one duplicated the component elements of Kofune then you would have two image capturing modules. As a driver's license is a two-dimensional object (i.e. a piece of paper), it would have been obvious to place the two image capturing modules on opposite sides of the two-dimensional object, thereby capturing the image from each side.

Authenticity Judging Module

Appellant asserts that Kofune does not disclose "an authenticity judging module which judges the driver's license is a forgery if neither of the watermarks image captured from the obverse nor reverse side by the driver's license image capturing module is recognized as a regular watermark." Appellant hinges his argument upon his particular interpretation of the claim language - "capturing a watermark of a driver's license from both obverse and reverse sides" – which Examiner refuted previously.

Kofune states:

Additionally, in the event that the object is validated as a specific one whose all print patterns are insensible to infrared light by the classifying apparatus, the **sensor mechanism may be constructed to read watermark patterns of the bank bills by a sensor and compare them with data on the watermark patterns of the true one stored in a memory, thereby being discriminatable**

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even to the forged ones produced by such a special color copying machine. (emphasis added - see col. 7, lines 34 – 41).

Examiner asserts that Kofune discloses an authenticity judging module which judges the driver's license is a forgery if neither of the watermarks image captured from the obverse nor reverse side by the driver's license image capturing module is recognized as a regular watermark.

Claim 14

Appellant asserts that Kofune does not disclose “if the watermark on the obverse is determined not regular, gathering second driver's license imaging data based on a watermark on the reverse side of the driver's license.”

Kofune states:

Additionally, in the event that the object is validated as a specific one **whose all print patterns are insensible to infrared light by the classifying apparatus, the sensor mechanism may be constructed to read watermark patterns of the bank bills by a sensor** and compare them with data on the watermark patterns of the true one stored in a memory, thereby being discriminatable even to the forged ones produced by such a special color copying machine. (emphasis added - see col. 7, lines 34 – 41).

Examiner asserts that Kofune discloses that if the watermark (print pattern) on the obverse is determined not regular (insensible to infrared light), gathering second driver's license imaging data (watermark pattern) based on a watermark on the reverse side (via transmission from reverse side) of the document.

Furthermore, Examiner asserts that such a method step is a conditional method step, as the claim limitation only is executed “if the watermark on the obverse is determined not regular.” Examiner asserts that it is reasonable to assume that the

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watermark on the obverse is determined to be regular thereby eliminating the performance of the conditional claim limitation.

Claims 3 and 4

Appellant asserts that Kofune does not disclose a “first and second camera to shoot the driver’s license from the obverse and reverse side.”

Kofune states:

In addition, it can be apparently understood that similar result can be obtained by constructing the validating apparatus with three elements, a common light emitter 4, a light detector 5 for receiving reflected light and a light detector 6 for receiving transmitted light, as shown in FIG. 12. (see col. 7, lines 18 – 22).

Examiner asserts that Kofune does disclose a first and second camera to shoot the object from the obverse and reverse side. (see fig. 12)

Claims 5 and 6

Appellant asserts that Kofune does not disclose “a revolving means for revolving the driver’s license between the lens and the light so that the obverse or the backside of the driver’s license is placed opposite to the lens.” Appellant argues that “revolving means” and “revolve” means “to turn or roll around on an axis” and that the disclosures of Kofune fail to teach such a claim limitation.

Kofune discloses a conveying means for positioning the driver’s license between the lens and the light so that the obverse or the backside of the driver’s license is placed opposite to the lens. (see fig. 6). As evidenced by the drawings of Kofune, the conveying means is, at least in one embodiment, a conveyor belt stretched between two revolving drums. The revolving drums cause the conveyor belt to turn on an axis,

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carrying the document lying on the conveyor belt, between the lens and the light so that the obverse of the backside of the driver's license is placed opposite to the lens.

Claims 7 and 8

All argument(s) and/or rationale(s) set forth above with respect to earlier addressed claim(s) are hereby incorporated and/or reapplied so as to apply to Claim(s) 7 and 8 where applicable.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jason M Borlinghaus/

Examiner, Art Unit 3693

September 17, 2008

Conferees:

/J. A. K./

James A Kramer

Supervisory Patent Examiner, Art Unit 3693

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